

## **REMARKS**

### ***Status of the Claims***

Claims 15-22, 29, and 30 are pending in the application. In this Response, claims 15-22, 29, and 30 have been amended.

Exemplary support for the amendments can be found throughout the claims and specification as filed. See, for example, page 23, lines 2-39 and page 24, lines 1-3.

Initially, Applicants note that at page 2 of the Office Action, the Examiner refers to illegible formulas submitted in the amendment filed on September 4, 2007. However, it appears that at page 2 of the Office Action, a substitute specification has been required. In this regard, the Examiner has clarified in an Interview Summary on April 17, 2008 that Applicants do not need to submit a substitute specification and submitting a response to the outstanding Office Action with legible formulas will overcome the objection raised at page 2 of the Office Action. Applicants submit that the formulas submitted in this amendment are legible and have not been amended since the original filing of the disclosure on October 7, 2005.

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejections in view of the foregoing amendments and the following remarks.

### ***Double Patenting***

Claims 15-22, 29, and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 10-22, particularly claim 18 of co-pending Application No. 10/552,520 ("the '520 application").

Applicants believe that the present claims are patentable over claims 10-22 of the '520 application. However, to facilitate allowable subject matter, Applicants will consider submitting a terminal disclaimer over the '520 application under separate cover, as appropriate, once allowable subject matter has been agreed upon.

The filing of a Terminal Disclaimer is not to be construed as an admission of the propriety of the rejection on obvious double patenting. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

***Rejections under 35 U.S.C. § 112***

(i) Claims 15-22, 29, and 30 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants respectfully submit that the amendments to the claims submitted herewith overcome the rejections set forth in items A - G.

With regard to the rejections set forth in item B., Applicants respectfully submit that claims 15 and 30 recite "...R<sub>1</sub> and R<sub>2</sub>, which are different or identical, are chosen from aliphatic radicals with no aromatic nucleus, substituted or unsubstituted, optionally alkyls..."

(ii) Claims 15-22, 29, and 30 have been rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for the disclosed substituents, does not reasonably provide enablement for all of the encompassed substituents by the claimed recitation of "substituted".

Applicants respectfully submit that amended claims 15 and 30 recite "R<sub>1</sub> and R<sub>2</sub>, which are different or identical, are substituted or unsubstituted aliphatic radicals with no aromatic nucleus, and optionally R<sub>1</sub> and R<sub>2</sub> are aliphatic radicals substituted with alkyls", the term "substituted" is sufficiently enabling in the manner disclosed at page 12, lines 26-30 of the specification. As the Examiner agrees that the specification is sufficiently enabling for the disclosed substituents, Applicants respectfully submit that the claims are also sufficiently enabling for at least the same reasons.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 112, first paragraph should be withdrawn.

(iii) Claims 15-22, 29, and 30 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Applicants respectfully submit that as noted hereinabove, the formulas submitted in this amendment are legible and have not been amendment since the original filing of the disclosure on October 7, 2005. Accordingly, Applicants respectfully submit that in view of the Interview Summary dated April 17, 2008, this rejection should be withdrawn.

***Rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103***

Claims 15-22, 29, and 30 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent Publication Number 2001/0021746 ("Nabavi"). Claims 15-22, 29, and 30 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Nabavi. These rejection are respectfully traversed.

A claim is anticipated only if *each and every* element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added).

The Office has the initial burden of establishing a *factual basis* to support the legal conclusion of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some *articulated reasoning with some rational underpinning* to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added).

Nabavi relates to isocyanate-based compounds and compositions. (Page 1, paragraph [0001]). Nabavi discloses composition based on isocyanate(s), advantageously not completely masked, characterized in that it comprises at least one compound containing an anionic functional group and advantageously a polyethylene glycol chain fragment of at least one, preferably at least 5 ethyleneoxy units. (Claim 1).

In contrast, amended independent claims 15 and 30 recite ***a method for using an adhesive emulsion*** comprising: applying the adhesive emulsion to join together at least two surfaces, wherein the adhesive emulsion comprises, *inter alia*, ***an aqueous phase with a pH of between 4 and 9***, optionally bearing an adhesive polymer, wherein the isocyanate composition (a), the surfactant (b), and the aqueous phase optionally bearing an adhesive polymer and added simultaneously or successively to form the adhesive emulsion, and wherein ***the adhesive emulsion includes particles having a particle size  $d_{50}$  of not more than***

***25  $\mu\text{m}$  and, optionally not more than 22  $\mu\text{m}$ , and the adhesive emulsion has a polydispersity index of not more than 1.5, and optionally not more than 1.3.***

Applicants respectfully submit that amended independent claims 15 and 30 are directed to the use of an adhesive emulsion of an emulsifiable isocyanate composition comprising an isocyanate composition and a surfactant. (See, for example, page 9, lines 17-36 and page 10, lines 1-22 of the present specification).

More particularly, Applicants respectfully submit that amended independent claims 15 and 30 are clearly related to the specific technical field of adhesives. (See, for example, page 1, lines 10-11; page 1, line 14; page 5, line 39; page 6, line 4; page 6, lines 20-36; page 7, line 16; page 7, lines 29-37; page 8, lines 15-17; page 9, lines 10-15; page 18, lines 37-38; page 19, lines 1-4; page 19, lines 38-39; page 23, lines 5-8; page 31, line 27; and examples at pages 35-36 of the present specification).

Applicants respectfully submit that the use of the ***adhesive emulsion*** in adhesives, as presently recited in amended independent claims 15 and 30, is neither disclosed nor suggested by the document Nabavi.

Further, Applicants respectfully submit that the compositions of Nabavi, in contrast to the presently pending claims, are directed to paints and varnishes. (See, for example, page 1, paragraphs [0005], [0010], and [0011]; page 9, paragraph [0165]; and page 10, Examples 10-13 of Nabavi). Applicants respectfully submit that Nabavi's paints and varnishes are directed to a technical field which is completely different from that of the presently recited use of adhesive emulsions.

In particular, Applicants respectfully submit that the requirements for Nabavi's varnish or paint compositions are completely different from those required for an adhesive composition. More particularly, Applicants respectfully submit that Nabavi's varnish and paint compositions are required to meet certain standards of gloss, chemical resistance, and hardness. (See, for example, page 10, Examples 10-13 of Nabavi). In contrast, the presently recited adhesive emulsion are required to meet standards of breaking strength and peeling. (See, for example, pages 35-36 of the present specification).

Accordingly, Applicants respectfully disagree with the Examiner's position that Nabavi's coating is the same as the presently recited adhesive. In this regard, Applicants respectfully submit definitions of a protective coating and an adhesive as set forth in Hawley, *The Condensed Chemical Dictionary*, Tenth Edition, page 867 (1981) and LeSota, *Coatings*

*Encyclopedic Dictionary*, Federation of Societies for Coatings Technology, page 8 (1995), respectively. As noted in Hawley, a protective coating serves decorative purposes and/or a protective function. In contrast, as noted in LeSota, an adhesive is a substance which is capable of holding materials together. As such, Applicants respectfully submit that the two definitions clearly distinguish adhesives and coatings as being distinct from one another.

In view of at least the foregoing, Applicants respectfully submit that a coating composition will not have the same behavior when used as a coating (*i. e.*, when deposited as a thin layer on a support) versus when used between two supports to be joined (*i.e.*, as an adhesive). In particular, Applicants respectfully submit that the drying properties of the two will not be the same.

Moreover, Applicants respectfully submit that Nabavi fails to disclose or suggest all the features recited in amended independent claims 15 and 30 which recite ***a method for using an adhesive emulsion*** comprising: applying the adhesive emulsion to join together at least two surfaces, wherein the adhesive emulsion comprises, *inter alia*, ***an aqueous phase with a pH of between 4 and 9***, optionally bearing an adhesive polymer, wherein the isocyanate composition (a), the surfactant (b), and the aqueous phase optionally bearing an adhesive polymer and added simultaneously or successively to form the adhesive emulsion, and wherein ***the adhesive emulsion includes particles having a particle size  $d_{50}$  of not more than 25  $\mu\text{m}$  and, optionally not more than 22  $\mu\text{m}$ , and the adhesive emulsion has a polydispersity index of not more than 1.5, and optionally not more than 1.3.***

As such, in light of at least the foregoing, Applicants respectfully submit that the anticipation and obviousness rejections over Nabavi should be withdrawn.

***Conclusion***

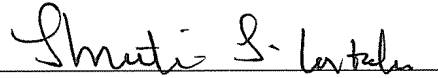
In view of at least the foregoing amendments and remarks, reconsideration of the claims and allowance of the subject application is earnestly solicited. In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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